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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,028	06/27/2001	Paul Karlstedt	975.340USW1	5698
32294	7590	06/01/2004	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P.			CHO, UN C	
14TH FLOOR			ART UNIT	
8000 TOWERS CRESCENT			PAPER NUMBER	
TYSONS CORNER, VA 22182			2682	9

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,028

Applicant(s)

KARLSTEDT ET AL.

Examiner

Un C Cho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The IDS submitted on 6/27/2001 has been considered and recorded in file.

Specification

2. The disclosure is objected to because of the following informalities:

Page 13, line 16 it recites "than" it should be "then" instead.

- Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 21, 25 and 27 – 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Syed et al. (US 6,038,451).

Regarding claim 21, Syed teaches monitoring the location of a mobile unit within the mobile telecommunications network using location information generated by, and available for the network, the monitoring being effected by querying data corresponding to the location of the mobile station from a location register of the network (Syed, Col. 2, lines 53 - 58); comparing the monitored location with a predetermined location within the network (Syed, Col. 2, lines 59 - 62); judging whether the monitored location corresponds to the registered locations and if the result is positive the network forwards the call to another terminal (Syed, Col. 2, lines 38 – 42).

Regarding claim 25, Syed teaches that the home location register has record of the location of each mobile unit present within the range of an associated mobile services switching center is kept (Syed, Col. 4, lines 63 – 67).

Regarding claim 27, Syed teaches that another terminal is a registered wireline terminal (Syed, Col. 3, lines 37 – 40).

Regarding claim 28, Syed teaches that the registered wireline terminal has been registered to receive a value added service (Syed, Col. 3, lines 40 – 43).

Regarding claim 29, Syed teaches that the request contains at least an identification of the registered wireline terminal and location information for the registered wireline terminal (Syed, Col. 3, lines 43 – 50).

Regarding claim 30, Syed teaches defining the predetermined location based on the location information for the predetermined terminal (Syed, Col. 3, lines 40 – 50).

Regarding claim 31, Syed teaches that the location information available for the network is cell information (Syed, Col. 3, lines 59 – 61).

Regarding claim 32, Syed teaches that the location information available for the network is location area information (Syed, Col. 3, lines 59 – 61).

Regarding claim 33, Syed teaches a telecommunication system adapted to carry out the method according to claim 21 (Fig. 1).

Regarding claim 34, Syed teaches a telecommunication network element adapted to carry out the method according to claim 21 (Syed, Col. 4, lines 35 – 47).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syed in view of Stenman et al. (US 6,223,029).

Regarding claim 22, Syed teaches the limitations of claim 21. However, Syed fails to teach a data message being a SMS message. In contrast, Stenman

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teaches a SMS message (Stenman, Col. 7, lines 33 – 35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Stenman to Syed to provide the mobile station with dual functionalities so that it is able to provide normal telephony functions and act as a remote control unit for a variety of peripheral devices accessible through some type of local area communication system or related communication system.

Regarding claim 23, Syed teaches the limitations of claim 21. However, Syed fails to teach a data message containing data for remotely controlling equipment assigned to another terminal. In contrast, Stenman teaches a control signal for remotely controlling peripheral device assigned to another terminal (Stenman, Col. 7, lines 49 – 52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Stenman to Syed to provide the mobile station with dual functionalities so that it is able to provide normal telephony functions and act as a remote control unit for a variety of peripheral devices accessible through some type of local area communication system or related communication system.

Regarding claim 24, the claim is interpreted and rejected for the same reason as set forth in claim 23.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Syed in view of Brennan et al. (US 5,329,578).

Regarding claim 26, Syed teaches the limitations of claim 21. However, Syed fails to teach that the message is transmitted only within a predetermined time range. In contrast, Brennan teaches that predetermined message is transmitted only within a predetermined time range (Brennan, Col. 6, lines 53 – 64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Brennan to Syed to provide a personal communication system which can be easily integrated with a network and be able to offer incoming call management and communication mobility while making use of the network based features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Un C Cho
Examiner
Art Unit 2682

UC 5/20/04


LEE NGUYEN
PRIMARY EXAMINER